II. REMARKS

A. Introduction

The Non-Final Office Action dated January 6, 1998 has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2, 3, 5, 6, 8-10, 12-14, 17, and 19 are amended. Claims 2-22 are pending in the application.

Claims 2-11 and 14-22 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-22 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by the USP 4,598,288 to Yarbrough. (hereinafter Yarbrough '101)

Claims 2-22 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.

Applicants respectfully traverse the requirements of the Final Office Action paragraph 4.

Paragraph 4 of the Final Office Action requires Applicants to either:

(1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or

(2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or

(3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

1. The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v.

Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).[1] Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule' s impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

[1] Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir 1988).

a. The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).[2] These two well established types of double patenting use an objective standard to determine when they are appropriate[3] and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327

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[2]MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquires set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

[3] The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

b. The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the

applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. Conclusion: Substantive Rule

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

> Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of* ***provisional*** *double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Final Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

(1) for failure to respond within a provided time period (under Rule 135);

(2) as an express abandonment (under Rule 138); or

(3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott,* 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Final Office Action's result of abandonment of Applicants' application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the

fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

7. Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

C. Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 1/30/96, 2/1/96, 4/5/96, and 4/7/97 and have addressed those specific concerns raised in the Office Action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

(1) the reasons for such a large number of references cited,

(2) foreign language references cited without a statement of relevance or translation have not been considered,

(3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of [11/3/81 or 9/11/87],

(4) citation of references apparently unrelated to the subject matter of the claimed invention, and

(5) citation of database search results listed in foreign languages where no copy was provided.

1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof,* No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

> "[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application."

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, "[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance." The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

3. References in the Information Disclosure Statements Subsequent to Applicants' Latest Effective Filing Date of 9/11/87

Examiner stated "[n]umerous references listed in the IDS are subsequent to the applicant's latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear." Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants' understanding that the effective filing date for the present application is 11/3/81.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

D. Response to Rejections under 35 U.S.C. § 112

1. Specification Support of the Claims

The Final Office Action rejects claims 2-11 and 14-22 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a. Claim 2

a controller operatively connected to said processor, said controller receiving said information transmission from said processor and detecting the status of a television display, said processor receiving status information from said controller about said television display, said processor at least one of (i) routing to said video storage device and (ii) actuating said video storage device to store a selected portion of said information transmission depending on the status of said television display.	For example, col. 19 lines 5-20.

b. Claim 3

processing said event signal based on said step of locating.	For example, Col. 19 lines 45-49, based on col. 19 lines 20-23.

c. Claim 10

informing said programmable receiver station of a variable event location	For example, col. 19 lines 5-8. For example, col. 4 lines 36-46. For example, col. 18 lines 59-63.

d. Claim 14

informing said television receiver station of at least one of: (1) a television program of interest, said television program designated by at least one of a title and subject matter	col. 19 lines 5-9.
determining said television monitor is not outputting at least a portion of said received television program	col. 19 lines 9-11.

e. Claim 17

informing said television receiver station of at least one of: (1) at least one of a title and subject matter of at least said portion of said television programming	col. 19 lines 5-9.
determining said television	col. 19 lines 9-11.

monitor is not outputting said at least said portion of said television programming based on said step of informing.	

f. Claim 18

In general, see col. 14 lines 20-25 and col. 15 lines 20-25.

storing operating instructions at a remote data source, said operating instructions enabling said receiver station to detect and react to one of the presence and the absence of said event signal	For example, col. 15 lines 22-25 with col. 14 lines 54-61, col. 9 lines 21-23 and col. 5 lines 19-20, in regard to col. 15 lines 1-7.
transmitting said operating instructions from said remote data source to said receiver station in response to said step of receiving said query, said receiver station selecting and storing at least some of said operating instructions	For example, col. 9 lines 21-23, col. 5 lines 19-21, and col. 15 lines 22-25.
transmitting from a second remote source to said receiver station a signal which controls said receiver station to at least one of locate and process to said event signal based on said operating instructions	For example, see col. 14 line 33 to col. 15 line 19.

g. Claim 19

receiving at a transmitter station said at least one digital instruct signal which is operative at said at least one receiver station to react to one of the presence and the absence of an event signal and delivering said at least one digital instruct signal to a transmitter	Col. 10 lines 61-64, col. 9 lines 31-33, and col. 11 lines 38-39 with col. 19 lines 14-15, lines 17-23, and lines 10-11.
receiving at said transmitter station at least one digital control signal which, at the receiver station , operates to communicate said at least one digital instruct signal to said at least one processor	Col. 10 lines 61-64, col. 9 lines 31-33, col. 11 lines 38-43, and lines 50-57.

2. Conclusion

Applicants respectfully submit that the rejected claims of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

E. Response to Rejection of Claims for Absence of Novelty

Applicants further respectfully submit that claims 2-22 in the present application should be allowed because these methods are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim

negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986).

1. 35 U.S.C. § 102 (b) Rejection over Yarbrough '101

Claims 2-22 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by the Yarbrough '101.

a. Claim 2

With respect to Applicants' claim 2, Yarbrough '101 fails to teach, *inter alia,* [a] television receiver station apparatus for detecting the status of a television display and storing a television program on a video storage device depending on the status of said television display. The office action, in its entirety states, "[t]he entire patent to Yarbrough teaches the claimed method of processing signals at a receiver station in order to automatically tune and record television programming. The claimed remote source and the transmitter have to be inherent since the programming needs to be transmitted from somewhere." Applicants respectfully disagree and submit that Yarbrough '101 fails to anticipate each and every element of Applicants claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131.

Yarbrough '101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program that includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. Col. 1 lines 40-50.

There is no suggestion of [a] television receiver station apparatus for detecting the status of a television display and storing a television program on a video storage device depending on the

status of said television display. In fact, even though Yarbrough '101 teaches that a predetermined action is one of receiving the broadcast, recording the broadcast, or disabling the operation of any recording equipment at the monitoring location, the action is based on the comparison at the monitoring location, not the status of any display. There is no suggestion whatsoever in Yarbrough '101 of taking any action based on the status of said television display.

Further, Yarbrough '101 fails to suggest of describe, a controller operatively connected to said processor, said controller receiving said information transmission from said processor and detecting the status of a television display, said processor receiving status information, from said controller about said television display, said processor at least one of routing to and actuating said video storage device to store, a selected portion of said information transmission depending on the status of said television display. Instead, Yarbrough '101 teaches a

> monitoring record and reception device which typically could include radio or television receiver for receiving a broadcast over the free air or by cable or via an input-output device connected to a telephone line. The encoded touch tone signal, after reception by unit 16, is split out or filtered by unit 17 which sends the encoded signal to the tone decoder 18 and the information signals to the receiving and/or recording device 19. col. 3 lines 59-67.

There is no mention in Yarbrough '101 of any controller, processor, or storage device that functions as Applicants claim, wherein the processor at least one of routing to and actuating said video storage device to store, a selected portion of said information transmission depending on the status of said television display. Yarbrough '101 simply receives the broadcast, splits the broadcast, and sends the encoded signal to decoder 18 and the informational signals directly to the recording device. Yarbrough '101 fails to anticipate Applicants claimed invention.

b. Claim 3

With respect to Applicants' claim 3, Yarbrough '101 fails to teach, *inter alia,* locating said event signal based on said step of reacting and processing said event signal based on said step of locating. Yarbrough '101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program that includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of locating said event signal based on said step of reacting and processing said event signal based on said step of locating. Yarbrough '101 does teach that the tape recorder is attached to a recording control unit 21 that is controlled by central processing unit 22 and may be used for switching the recording device on or off, switching channels, or scrambling. However, Yarbrough '101 is silent as to locating an event based on any processor control. Yarbrough '101 fails to suggest or describe locating said event signal based on said step of reacting and processing said event signal based on said step of locating. Yarbrough '101 fails to anticipate Applicants claimed invention.

c. Claim 10

With respect to Applicants' claim 10, Yarbrough '101 fails to teach, *inter alia,* informing said programmable receiver station of a variable event location and detecting one of the presence and the absence of said event signal based on said step of informing. Yarbrough '101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program which includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of informing said programmable receiver station of a variable event location and detecting one of the presence and the absence of said event signal based on said step of informing. Instead, Yarbrough '101 simply teaches receiving a broadcast over the free air or

by cable or via an input-output device connected to a telephone line. Col. 3 lines 61-62. There is no concept in Yarbrough '101 of informing any programmable receiver station. Further, Yarbrough '101 is silent as to detecting any presence or absence of any signal, since the monitoring station is only designed to receive the broadcast and store the information included in the broadcast.

Further, Yarbrough '101 is silent as to reacting, under said processor control, based on said step of detecting. In fact, Yarbrough's predetermined action (as described above) is done so based on a comparison at the monitoring station. There is no concept of reacting, under said processor control, based on said step of detecting, when detecting the location event signal is based on the step of informing said programmable receiver station of a variable event location. Since Yarbrough '101 is silent as to reacting based on any detected absence of any event signal, then clearly Yarbrough '101 fails to suggest or describe processing said event signal based on said step of reacting and outputting programming based on said step of processing. Yarbrough '101 fails to anticipate Applicants claimed invention. Further, Yarbrough '101 does teach that the tape recorder is attached to a recording control unit 21 that is controlled by central processing unit 22 and may be used for switching the recording device on or off, switching channels, or scrambling. However, Yarbrough '101 is silent as to processing an event based on any processor control. Yarbrough '101 fails to suggest or describe processing said event signal based on said step of reacting and outputting programming based on said step of proccesing. Yarbrough '101 fails to anticipate Applicants claimed invention.

d. Claim 12

With respect to Applicants' claim 12, the reference fails to teach, *inter alia,* processing said event signal based on said step of reacting and outputting programming based on said step of

processing. Yarbrough '101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program that includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of processing said event signal based on said step of reacting and outputting programming based on said step of processing. Yarbrough '101 does teach that the recorder is attached to a recording control unit 21 that is controlled by central processing unit 22 and may be used for switching the recording device on or off, switching channels, or scrambling. However, Yarbrough '101 is silent as to processing said event signal based on said step of reacting and outputting programming based on said step of processing. Yarbrough '101 fails to anticipate Applicants claimed invention.

e. Claim 14

With respect to Applicants' claim 14, Yarbrough '101 fails to teach, *inter alia,* informing said television receiver station of at least one of: (1) a television program of interest, said television program designated by at least one of a title and subject matter; and (2) a time to at least one of receive and display a television program. Instead, Yarbrough '101 teaches a method of selectively receiving and recording a broadcast of an audio or video program that includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of informing said television receiver station of at least one of: (1) a television program of interest, said television program designated by at least one of a title and subject matter; and (2) a time to at least one of receive and display a television program.

Further, there is no suggestion of receiving and displaying a television program, as claimed by Applicants. Instead, Yarbrough '101 teaches receiving a broadcast over the free air or by cable or via an input-output device connected to a telephone line, wherein an encoded signal is sent to the tone decoder and an informational signal is sent to the recording device. Col. 3 lines 61-68. Yarbrough '101 is completely silent as to receiving and displaying, as claimed by Applicants. Further, there is no concept in Yarbrough '101 of informing said television receiver station of at least one of: (1) a television program of interest, said television program designated by at least one of a title and subject matter; and (2) a time to at least one of receive and display a television program.

Further, Yarbrough '101 is silent as to receiving a television program based on said step of informing, since clearly there is no concept of informing the receiver station of anything, especially a television program of interest, said television program designated by at least one of a title and subject matter; and a time to at least one of receive and display a television program, as claimed by Applicants.

Further, Yarbrough '101 is completely silent as to determining said television monitor is not outputting at least a portion of said received television program and controlling at least one apparatus based on said step of determining. Again, Yarbrough '101 is simply designed to receive the broadcast, split the broadcast, and send the encoded signal to decoder 18 and the informational signals directly to the recording device. There is no concept of determining said television monitor is not outputting at least a portion of said received television program and

controlling at least one apparatus based on said step of determining. Yarbrough '101 fails to anticipate Applicants claimed invention.

f. Claim 17

With respect to Applicants' claim 17, the reference fails to teach, *inter alia,* informing said television receiver station of at least one of: (1) at least one of a title and subject matter of at least a portion of said television programming; and (2) a time to at least one of receive and display said at least said portion of said television programming. Yarbrough '101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program which includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of informing said television receiver station of at least one of: (1) at least one of a title and subject matter of at least a portion of said television programming; and (2) a time to at least one of receive and display said at least said portion of said television programming.

Further, there is no suggestion of receiving and displaying a television program, as claimed by Applicants. Instead, Yarbrough '101 teaches receiving a broadcast over the free air or by cable or via an input-output device connected to a telephone line, wherein an encoded signal is sent to the tone decoder and an informational signal is sent to the recording device. Col. 3 lines 61-68. Yarbrough '101 is completely silent as to receiving and displaying, as claimed by Applicants. Further, there is no concept in Yarbrough '101 of informing said television receiver station of at least one of: (1) at least one of a title and subject matter of at least a portion of said

television programming; and (2) a time to at least one of receive and display said at least said portion of said television programming.

Further, Yarbrough '101 is completely silent as to determining said television monitor is not outputting said at least said portion of said television programming based on said step of informing. Again, Yarbrough '101 is simply designed to receive the broadcast, split the broadcast, and send the encoded signal to decoder 18 and the informational signals directly to the recording device. There is no concept of determining said television monitor is not outputting said at least said portion of said television programming based on said step of informing.

Since Yarbrough '101 is silent as to Applicants claimed determining step, clearly Yarbrough '101 fails to suggest or describe performing, under processor control based on said step of determining, at least one of the group consisting of: (1) receiving said at least said portion of said television programming; (2) outputting said at least said portion of said television programming; and (3) storing said at least said portion of said television programming. Yarbrough '101 is does disclose receiving the broadcast, splitting the broadcast, and sending the encoded signal to decoder 18 and the informational signals directly to the recording device. However, such action in Yarbrough '101 is to based on any determining as claimed by Applicants. Therefore, there is no concept of performing, under processor control based on said step of determining, at least one of the group consisting of: (1) receiving said at least said portion of said television programming; (2) outputting said at least said portion of said television programming; and (3) storing said at least said portion of said television programming. Yarbrough '101 fails to anticipate Applicants claimed invention.

g. Claim 18

With respect to Applicants' claim 18, Yarbrough '101 fails to teach, *inter alia,* storing operating instructions at a remote data source, said operating instructions enabling said receiver station to detect and react to one of the presence and the absence of said event signal. Yarbrough

'101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program which includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of storing operating instructions at a remote data source, said operating instructions enabling said receiver station to detect and react to one of the presence and the absence of said event signal. In fact, Yarbrough '101 teaches that the predetermined action is one of receiving the broadcast, recording the broadcast, or disabling the operation of any recording equipment at the monitoring location. There is no suggestion of enabling said receiver station to detect and react to one of the presence and the absence of said event signal nor is there any suggestion of operating instructions that function as Applicants claim. Instead, any action at the monitoring station of Yarbrough '101 is based on the comparison (see above citation) at the monitoring location, not any operating instructions.

Further, Yarbrough '101 fails to suggest or describe transmitting said operating instructions from said remote data source to said receiver station in response to said step of receiving said query, said receiver station selecting and storing at least some of said operating instructions. Yarbrough '101 does disclose the generation and transmission of program material in block 10 that the home user would have some interest in and would desire to either receiver and/or record for later use. Col. 2 lines 1-10. However, there is no suggestion whatsoever of transmitting said operating instructions from said remote data source to said receiver station in response to said step of receiving said query, said receiver station selecting and storing at least some of said operating instructions. Yarbrough '101 simply receives the broadcast, splits the broadcast, and sends the encoded signal to decoder 18 and the informational signals directly to

the recording device. There is no suggestion of selecting and storing at least some of said operating instructions.

Further, there is no concept of transmitting from a second remote source to said receiver station a signal which controls said receiver station to at least one of locate and process to said event signal based on said operating instructions. First, Yarbrough '101 only discloses one remote source which is block 10 as clearly illustrated in figure 1. Secondly, block 10 which does generate and transmit program material to the monitoring device, does not anticipate transmitting a signal which controls said receiver station to at least one of locate and process to said event signal based on said operating instructions. Again, as previously stated, Yarbrough '101 is designed to receive the broadcast, split the broadcast, and send the encoded signal to decoder 18 and the informational signals directly to the recording device. There is no disclosure of a second remote source nor is there any mention of transmitting any signal that locates or processes an event signal based on operating instructions. Yarbrough '101 fails to anticipate Applicants claimed invention.

h. Claim 19

With respect to Applicants' claim 19, Yarbrough '101 fails to teach, *inter alia,* receiving at a transmitter station said at least one digital instruct signal which is operative at said at least one receiver station to react to one of the presence and the absence of an event signal and delivering said at least one digital instruct signal to a transmitter. Yarbrough '101 teaches a method of selectively receiving and/or recording a broadcast of an audio and/or video program which includes the following steps:

> first, signals are encoded on program segments to be broadcast which identify the type of segment. The broadcast is monitored and these encoded signals are decoded. Then the decoded signals are compared with pre-stored code at the monitoring location and a predetermined action is taken with respect to the comparison. col. 1 lines 40-50.

There is no suggestion of receiving at a transmitter station said at least one digital instruct signal which is operative at said at least one receiver station to react to one of the presence and the absence of an event signal and delivering said at least one digital instruct signal to a transmitter. In fact, Yarbrough '101 teaches that the predetermined action is one of receiving the broadcast, recording the broadcast, or disabling the operation of any recording equipment at the monitoring location. There is no suggestion of any digital instruct signal that [reacts] to one of the presence and the absence of said event signal nor is there any suggestion of any delivering such to a transmitter.

Further, Yarbrough '101 fails to suggest or describe receiving at said transmitter station at least one digital control signal which, at the receiver station , operates to communicate said at least one digital instruct signal to said at least one processor. Yarbrough '101 does disclose the generation and transmission of program material in block 10 (transmitter) that the home user would have some interest in and would desire to either receiver and/or record for later use. col. 2 lines 1-10. However, there is no suggestion whatsoever of receiving at said transmitter station at least one digital control signal which, at the receiver station , operates to communicate said at least one digital instruct signal to said at least one processor. Yarbrough '101 simply receives the broadcast at the receiver, splits the broadcast, and sends the encoded signal to decoder 18 and the informational signals directly to the recording device. There is no suggestion of any digital control signal which, at the receiver station , operates to communicate said at least one digital instruct signal to said at least one processor.

Further, since Yarbrough '101 is silent as to Applicants claimed digital instruct signal and digital control signals, then clearly there is no concept transferring said at least one digital control signal to said transmitter, said transmitter transmitting said at least one digital instruct signal and said at least one digital control signal. Block 10 in Yarbrough '101 generates and

transmits program material to the monitoring device. However, the generated program material which is response to the home users request, is not disclosed as functioning as Applicants claim. Further, the monitoring station, of Yarbrough '101, which receives the program material broadcast, simply splits the broadcast, and sends the encoded signal to decoder 18 and the informational signals directly to the recording device. There is no disclose of any digital instruct signal or digital control signals that functions as Applicants claim. Yarbrough '101 fails to anticipate Applicants claimed invention.

i. Claims 4-9, 11, 13, 15, 16, and 20-22

Claims 4-9, 11, 13, 15, 16, and 20-22 depend upon independent claims 2, 3, 10, 12, 14, and 17-19. As discussed *supra,* Yarbrough '101 fails to disclose every element of claims 2, 3, 10, 12, 14, and 17-19 and thus, *ipso facto*, Yarbrough '101 fails to anticipate dependent claims 4-9, 11, 13, 15, 16, and 20-22, and therefore, this rejection should be withdrawn and the claim be permitted to issue.

Applicants respectfully submit that the cited art does not anticipate claims 2-22 since the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claims 2-22 be withdrawn.

III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Respectfully submitted,

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